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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,501	04/17/2001	Lawrence M. Kaplan	N0089US	8539

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09/30/2002

NAVIGATION TECHNOLOGY  
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STE 900  
CHICAGO IL. 60654-1105

EXAMINER

LOUIS JACQUES, JACQUES H

ART UNIT PAPER NUMBER

3661

remail 10-30-02  
DATE MAILED: 09/30/2002 DRG

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/836,501

Applicant(s)

KAPLAN, LAWRENCE M.

Examiner

Jacques H. Louis-Jacques

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-17 and 20-23 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

**DETAILED ACTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to a geographic database, classified in class 701, subclass 208.
  - II. Claims 8-23, drawn to a method of operation for an end's user computing device the provided navigation-related services, classified in class 701, subclass 209.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of operation for an end's user computing device the provided navigation-related services as claimed can be practiced by another materially different geographic database or by hand, and the geographic database as claimed can be used to practice another and materially different "method of operation for an end's user computing device the provided navigation-related services".
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Frank J. Kozak (Reg. No. 32,908) on September 25, 2002 a provisional election was made without traverse to prosecute the invention of Group II, claims 8-23. Affirmation of this election must be made by applicant in replying to

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this Office action. Claims 1-7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

5. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Both claims 14 and 10 recite the same limitations and depend on the same base claims.

However, it appears that claim 14 should have recited ‘...are unavailable wireless.’ in line 3. For examination purpose, the examiner has considered claim 14 to recite such limitation. Applicant is required to cancel or amend the claim accordingly.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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7. Claims 8-10, 14-17, 20-23 rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al [6,400,690].

Liu et al discloses a dual map system, for navigation and wireless communication, wherein a user using a computing device (110) establishes a wireless communication link through a wireless communications device (115) with a remotely located navigation services provider (101). According to Liu et al, as set forth in the abstract and column 2, for example, the user obtains wireless coverage data from the remotely located navigation service provider. The system of the remotely located navigation services provider comprises several managers including a coverage manager for indicating areas in which navigation-related data from the navigation services provider are available or unavailable wirelessly, i.e., the system indicates the user whether he/she is in an area covered wirelessly. See column 3 and figure 1.

Additionally, Liu et al discloses an output device (111), such as a display (column 2) for displaying on a screen areas in which navigation related data from the services providers are available or unavailable wirelessly.

Furthermore, Liu et al discloses, as described in the abstract and column 2, in particular, providing a warning to the user that he is or he is out of an area covered wirelessly by the navigation related services provider. The output device (111) of Liu et al can be a speaker or a display; thereby the warning is provided either audibly or visually. See columns 2-3.

In column 4, Liu et al discloses that the coverage manager interacts with a GPS for predicting the future wireless coverage, wherein the coverage manager notifies the user

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that he/she will soon lose coverage or soon will regain coverage and then the coverage manger refines the coverage map. That is, the coverage manager downloads data for a second area prior to leaving a first area. As further described in columns 4 and 5, the second area corresponds to a destination to which the user is traveling and which is located outside the first area. Also, the second area corresponds to a portion of a route on which the user's vehicle is located.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al in view of Pu et al [6,292,743]

Liu et al does not particularly disclose highlighting or coloring of the map data and indicating boundaries. Pu et al, on the other hand, discloses a mobile navigation system, which establishes a wireless communication with a navigation server, wherein the map data that are available or unavailable are highlighted. Also, according to Pu et al, there is provided an indication of the boundaries where the data are available. See for example column 10 thus, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the dual map system of Liu et al by

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incorporating the features from the mobile navigation system of Pu et al, such modification, will eliminate or reduce the burden on the user.

***Allowable Subject Matter***

10. Claims 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record do not particularly discloses restricting selection of destinations and routes to those in which navigation-related data from the navigation services provider are available wirelessly as claimed.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,948,042	Heimann et al	Sep. 1999
6,138,072	Nagai	Oct. 2000
6,374,177	Lee et al	Apr. 2002

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H. Louis-Jacques whose telephone number is (703) 305-9757. The examiner can normally be reached on M-Th, 7:30 AM - 4:00 PM (Eastern Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A. Cuchlinski can be reached on (703) 308-3873. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1111.

Jacques H. Louis-Jacques  
Primary Examiner  
Art Unit 3661

/jlj  
September 26, 2002

*Jacques H. Louis-Jacques*  
JACQUES H. LOUIS-JACQUES  
PRIMARY EXAMINER